

PATENT

Atty. Dkt. No. 2685/5434 (2000-0093)

REMARKS

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. § 102 and § 103. Thus, the Applicant believes that all of these claims are now in allowable form.

I. IN THE SPECIFICATION

The Examiner has objected to the specification because it is unclear as to what "receiving a computer" means in line 3 of the abstract. In response, the Applicant has amended the Abstract to read "for coupling to the computer". As such, the Applicant respectfully requests the objection be withdrawn.

II. CLAIM OBJECTIONS

The Examiner has objected to claim 28 because of informalities, namely the limitation "receiving a computer at said port" recited in line 3. In response, the Applicant has amended claim 28, line 3, to read "coupling a computer to said port". As such, the Applicant respectfully requests the objection be withdrawn.

III. REJECTION OF CLAIM 9 UNDER 35 U.S.C. §112

The Examiner has rejected claim 9 under 35 U.S.C. 112 as being indefinite. In response, the Applicant has amended claim 9 and respectfully submits that claim 9 is no longer indefinite. As such, the Applicant respectfully requests the rejection be withdrawn.

IV. REJECTION OF CLAIMS 1-9, 11-12, 14-21, 23-29 AND 31 UNDER 35 U.S.C. § 102

The Examiner rejected claims 1-9, 11-12, 14-21, 23-29 and 31 as being anticipated by Tingley, et al. (US Publication 2002/0138628, Published September 26, 2002, hereinafter referred to as "Tingley"). The rejection is respectfully traversed.

The Examiner's use of the Tingley application as prior art against Applicant's invention, by itself, is improper. More specifically, the Tingley patent was filed on

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January 22, 2002. The present application was filed on May 1, 2001. Since the filing date of the present application precedes the filing date of the Tingley patent, the Tingley patent is not prior art to Applicant's invention.

Applicant notes that the Tingley application claims priority to a provisional patent application filed January, 25, 2001 (hereinafter referred to as the "Tingley provisional application"). Under 35 U.S.C. §102(e), the filing date of a provisional patent application may be the effective filing date of a United States patent claiming priority to such provisional patent application only to the extent that such provisional patent application supports the subject matter used to make the rejection. See MPEP §706.02(f). Thus, the Examiner must provide some evidence that the Tingley provisional application supports the subject matter of the published Tingley application used in the rejection. Specifically the Applicant is questioning whether the Tingley provisional application contains the subject matter used by the Examiner in the rejection.

Notably, there is no prohibition against the inclusion of subject matter in a non-provisional patent application that was not described in a prior provisional application to which the non-provisional application claims priority. That is, a non-provisional patent application may include new material not described in the provisional application. It is axiomatic that such new material does not receive the benefit of the provisional application. Applicant is not aware of any law, rule, or otherwise that all subject matter described in a non-provisional application is presumed to be described in a provisional application to which the non-provisional application claims priority. Thus, it is possible that the subject matter in the published Tingley application relied on by the Examiner is not described in the Tingley provisional application (i.e., the subject matter in the published Tingley application relied on by the Examiner may constitute new material with respect to the Tingley provisional application). In such a case, the cited subject matter would not constitute prior art to Applicant's invention. Therefore, in order to set forth a prima facie case, the Examiner must provide evidence that the Tingley provisional application supports the subject matter of the published Tingley application used by the Examiner in the rejection. As such, without such evidence, the Applicant respectfully requests the rejection be withdrawn.

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II. REJECTION OF CLAIMS 10, 13, 22, 30 AND 32-35 UNDER 35 U.S.C. § 103**A. Claims 10, 13 and 30**

The Examiner rejected claims 10, 13 and 30 as being unpatentable over Tingley in view of Miner et al. (US Patent 6,804,332, issued October 12, 2004, hereinafter referred to as "Miner".) The rejection is respectfully traversed.

As discussed above, Applicant respectfully submits that the published Tingley application is not proper prior art without evidence that the Tingley provisional application supports the subject matter of the published Tingley application used by the Examiner in the rejection. As such, the alleged combination of Tingley with Miner as a rejection against claims 10, 13 and 30 is improper because Tingley is not a proper prior art reference. Therefore, Applicant contends that claims 9 and 28 are patentable over Tingley and Miner and, as such, fully satisfy the requirements of 35 U.S.C. §103.

Furthermore, claims 10, 13 and 30 depend, either directly or indirectly, from claims 9 and 28 and recite additional features. Since Tingley and Miner do not render obvious Applicant's invention as recited in claims 9 and 28, dependent claims 10, 13 and 30 are also not obvious and are allowable. As such, the Applicant respectfully requests the rejection be withdrawn.

B. Claim 22

The Examiner rejected claim 22 as being unpatentable over Tingley in view of Thornton et al. (US Patent 6,363,065, issued March 26, 2002, hereinafter referred to as "Thornton".) The rejection is respectfully traversed.

As discussed above, Applicant respectfully submits that the published Tingley application by itself is not proper prior art without evidence that the Tingley provisional application supports the subject matter of the published Tingley application used by the Examiner in the rejection. As such, the alleged combination of Tingley with Thornton as a rejection against claim 22 is improper because Tingley is not a proper prior art

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reference. Therefore, Applicant contends that claim 20 is patentable over Tingley and Thornton and, as such, fully satisfies the requirements of 35 U.S.C. §103.

Furthermore, claim 22 depends from claim 20 and recites additional features. Since Tingley and Thornton does not render obvious Applicant's invention as recited in claim 20, dependent claim 22 is also not obvious and is allowable. As such, the Applicant respectfully requests the rejection be withdrawn.

C. Claims 32-35

The Examiner rejected claims 32-35 as being unpatentable over Tingley in view of Fluss (US Patent 6,304,578, issued October 16, 2001, hereinafter referred to as "Fluss".) The rejection is respectfully traversed.

As discussed above, Applicant respectfully submits that the published Tingley application by itself is not proper prior art without evidence that the Tingley provisional application supports the subject matter of the published Tingley application used by the Examiner in the rejection. As such, the alleged combination of Tingley with Fluss as a rejection against claims 32-35 is improper because Tingley is not a proper prior art reference. Therefore, Applicant contends that claim 32 is patentable over Tingley in view of Fluss and, as such, fully satisfies the requirements of 35 U.S.C. §103.

Furthermore, claims 33-35 depend from claim 32 and recite additional features. Since Tingley in view of Fluss does not render obvious Applicant's invention as recited in claim 32, dependent claims 32-35 are also not obvious and are allowable. As such, the Applicant respectfully requests the rejection be withdrawn.

Conclusion

Thus, the Applicant submits that all of these claims now fully satisfy the requirement of 35 U.S.C. §102 and §103. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is

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requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

2/2/05

Moser, Patterson & Sheridan, LLP
595 Shrewsbury Avenue
Shrewsbury, New Jersey 07702



Kin-Wah Tong, Attorney
Reg. No. 39,400
(732) 530-9404